

## REMARKS

Claims 1-36 are pending in this application. Claims 11 and 12 have been amended to correct typographical errors.

### **Species Election Requirement**

The Office Action alleges that the present “application contains claims directed to the following patentably distinct species: a target metal ion, a complexing agent, and a non-hydrogen imaging nucleus.” Page 2 of the Office Action. In particular, the Office Action has required the Applicants to elect species that correspond to “a specific target metal ion, a specific complexing agent, and a specific non-hydrogen imaging nucleus to which the preliminary search will be limited.” Page 3 of the Office Action. However, the Office Action acknowledges that “In accordance with Markush practice, if the elected species are not found during a search of the prior art, the search will be expanded to include additional non-elected species.” *Id.*

Applicants traverse this Election of Species Requirement. However, since Applicants are required under 35 USC §121 to elect a single species even though the requirement is traversed, Applicants elect the following in accordance with the species election requirement:

target metal ion:  $Zn^{+2}$

complexing agent: 1,2-bis-(2-amino-5-trifluoromethylphenoxy)ethane-N,N,N',N'-tetraacetic acid

non-hydrogen imaging nucleus:  $^{19}F$

Claims 1-6 and 9-36 encompass the elected species.

The species election is made solely in the interest of expediting the prosecution of this application. As reasons for traversal, Applicants assert as follows: it is well established that it is improper to refuse to examine that which Applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Weber*, 198 USPQ 328 (CCPA 1978); *In re Haas*, 198 USPQ 334 (CCPA 1978); *In re Harnish*, 631 F.2d 716, 296 USPQ 300 (CCPA 1980); *Ex Parte Hozumi*, 3 USPQ2d 1059 (Bd. P. App. & Int. 1984). Unity of invention is determined by the presence of common utility and a common structural feature. See, for example, MPEP §803.02.

In view of the decisions in *In re Weber*, 198 USPQ 328 (CCPA 1978); and *In re Haas*, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which Applicants regard as their invention, unless the subject matter in a claim lacks unity of invention; *In re Harnish*, 631 F.2d 716, 296 USPQ 300 (CCPA 1980); *Ex Parte Hozumi*, 3 USPQ2d 1059 (Bd. P. App. & Int. 1984). Applicants consider their invention to comprise a method for *in vivo* magnetic resonance imaging of a target metal ion by administering an MRI contrast agent that comprises a complexing agent that is capable of binding to the target metal ion; acquiring imaging signals; generating at least one image map using the acquired imaging signal; and correlating intensity of the image pixel with concentration of the target metal ion in the tissue. It is this broad technique which is sought to be patented by the Applicants. This method is not limited to any particular target metal ion, complexing agent, or non-hydrogen imaging nucleus. The method is applicable to a variety of target metal ions, complexing agents, and non-hydrogen imaging nucleus.

Accordingly, Applicants respectfully request that the Examiner withdraw the requirement to elect a single species and examine the entire claim on the merits. In the event that the Examiner does not withdraw the species election requirement, Applicants' understanding is that the Examiner will follow the procedure set forth in M.P.E.P. §809.02(c), which provides for a complete action on the merits of all claims readable on the elected species. In addition, it is understood that the Examiner will also follow the procedure set forth in M.P.E.P. §803.02, whereby upon the finding of allowable species, examination will continue with the non-elected species until all species have been examined or a non-allowable species is found. Unlike a restriction requirement, the present species election does NOT preclude Applicants from pursuing the original form of the claim in subsequent prosecution, nor does it force Applicants to file multiple divisional applications which are incapable of capturing the intended scope of the application.

## CONCLUSION

If the Examiner believes a telephone conference would aid in the prosecution of this case in any way, please call the undersigned at (303) 955-8103.

Respectfully submitted  
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